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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,484	12/11/2001	Achim Franck	tesa AG 1510-WCG	1006
27386	7590	01/31/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on 11/30/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 3-13, 15-18 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1, 5, 7, 8, 10-13, 17, 18 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 120304
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that with respect to applicants' remarks (Response, pages 4-5) concerning the 35 U.S.C. § 112, first paragraph rejection of record, it is noted that this particular rejection was previously withdrawn in the Advisory Action dated October 1, 2004.

3. Claims 1, 5, 7, 8, 10-13, 17 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, upon careful review it appears that there are still quite a few informalities and related translation errors in the claims that need to be carefully corrected; the Examiner will attempt to point out all of these errors but notes that some may well be overlooked and he urges applicants to correct them. In claim 1 and throughout the claims there is no structure whatsoever with respect to the "surface" that is bonded to the double sided adhesive sheet, and it also appears that in claim 1, line 2, claims 10, 11 and elsewhere the double sided adhesive sheet is also referred to at times as a "strip" which is seen to add no meaningful structure to the claimed limitation. In claim 1, line 6, the phrase "of a kind that is" is clearly vague,

indefinite and redundant, and in claim 1, line 7, the phrase "the strip in the direction of the bond plane" also lacks antecedent basis with respect to this particular second element. In claim 5 Markush language should be utilized and in claim 7 the phrase "the areas of said surface" and "said two opposite edges of said surface" each appear to lack antecedent basis. In claim 8, line 1, there is no meaningful relationship set forth between the "spacers" and the remainder of the claimed "device". In claim 11, as it was previously noted, not only does "the adhesive sheet strip" appear to be vague and indefinite, but it appears that the same element is referred to later on as "the sheet" (line 2) and "the adhesive sheet" (line 3), thus leading to a clearly confusing claim structure. In claim 12 the phrase "wherein the surface . . . adhesive sheet strip . . . surface . . . the surface of the device" appears vague, indefinite and confusing, and also appears to lack antecedent basis. In claim 13, line 2, the phrase "its front face, laterally or both" is vague, indefinite and confusing, and in claim 17, line 1, the claim is dependent upon now cancelled claim 9.

4. Claims 1, 5, 7, 8, 10-13, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al. -397, substantially for reasons of record, as most recently set forth

in paragraph No. 7 of Paper No. 032504. More particularly, applicants do not appear to have appreciated (note, e.g. the heading of the rejection on page 6 of the Response after the first complete paragraph) that an anticipation rejection has also been relied upon by the Examiner, which essentially does not appear to have been responded to by applicants, so it is hereby repeated. That is, the Examiner still believes that in the absence of a suitable showing which has not as yet been produced that the reference is an inherent anticipation of both applicants' broad and at least several of the dependent claims, since the average roughness  $R_a$  and average depth of roughness  $R_z$  and their corresponding ranges are each believed to be inherent in at least certain embodiments of the disclosed genus of embodiments or, alternatively, at most an obvious optimization to one of ordinary skill in the art. Thus, such arguments as that presented (Response, page 7, second complete paragraph) as discussing inherency only in connection with obviousness have simply not addressed the anticipation rejection of record. Finally, with respect to applicants' remarks (Response, page 8, first complete paragraph) regarding the data presented on page 10 of the specification, it is noted that only conclusions, and no factual evidence appears to have been set forth therein and there also appears to be no basis for applicants' conclusion that "the

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applicants were able to reduce the tear frequency to unexpected low levels", as well as the conclusion without apparent testing that "none of the Lühmann references suggest what applicants have been able to accomplish." In summary, applicants appear to have not rebutted the prima facie case of record.

5. The Examiner has made applicants' IDS of December 3, 2004 of record; however, it is noted that only U.S. Patent 5,928,747 is a newly presented reference as the remaining three references are already of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through

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Dzirker:cdc

January 26, 2005

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1900~~  
1700

*Daniel Zinker*